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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,100	02/24/2006	Valentino Mercati	2503-1193	7193

466 7590 03/08/2011

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EXAMINER	
FELTON, MICHAEL J	
ART UNIT	PAPER NUMBER
1747	

NOTIFICATION DATE	DELIVERY MODE
03/08/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/564,100
Filing Date: February 24, 2006
Appellant(s): MERCATI, VALENTINO

Robert E. Goozner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/20/2010 appealing from the Office action mailed 4/26/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

24-40 and 47 are rejected and pending

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejection of claims 26-30 under 35 U.S.C. 112, second paragraph, have been withdrawn in view of the claim amendments received on 10/19/2010 and entered on 10/27/2010. The claim amendments correct the antecedent basis issue raised in the rejection.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,298,859	KIERULFF et al.	10-2001
3,265,209	WOCHNOWSKI et al.	08-1966
4,941,484	CLAPP et al.	07-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims **24-36 and 47** are rejected as being unpatentable over Kierulff et al. (US 6,298,859) in view of Wochnowski et al. (US 3,265,209).

Regarding claims **24-34**, Kierulff et al. teach solvent extraction of tobacco leaves (including flue cured Virginia tobacco (i.e. Nicotiana tabacum), col. 20, lines 49-51)

using 30-100% water and ethanol (col. 3, line 61--co1.4, line 58) in amounts of 5-200 times the weight of tobacco to be treated, at temperatures of 10-80° C for 5 minutes to 24 hours (col. 5, 31-45). After the extract is separated from the tobacco reside (i.e. extracted tobacco leaves), further treatment such as drying is performed (col. 6, 11-12).

Kierulff et al. do not expressly disclose elimination of the ribs. However, Wochnowski et al. disclose a method and apparatus for elimination of the ribs from the tobacco. It would have been obvious to one of ordinary skill in the art at the time of invention to use the method and apparatus of Wochnowski et al. either before or after extraction process of Kierulff et al. in order to provide a lighter blend of tobacco particles for smoking articles. Wochnowski et al. disclose that the process is used to allow different mixtures of tobacco to be produced, "including lighter and/or heavier particles of different specific weight, moisture contents, configuration, thickness, flexibility or other characteristics" (col. 1,46-49). It would have been obvious to one of ordinary skill that the rib portions have different characteristics as taught by Wochnowski et al. and could be separated by the method disclosed.

Regarding claim **35 and 36**, Kierulff et al. disclose extraction treatment one time using the extraction solvent.

Regarding claim **40**, Kierulff et al. disclosing using Virginia tobacco. Virginia tobacco is also known as bright tobacco, therefore Kierulff et al. disclose treating the same starting material (see also DIMON tobacco glossary, "bright leaf").

Regarding claim **47**, Kierulff et al. disclose using buffers that would adjust the pH of the solvent (col. 11, line 65--col. 12, line 4; and).

Claims 37-39 are rejected as being unpatentable over Kierulff et al. (US 6,298,859) and Wochnowski et al. (US 3,265,209) as applied to claim 24 above, in further view of Clapp et al. (US 4,941,484).

Regarding claim **37**, although Kierulff et al. teach that drying is performed (col. 6, 11-12) after the extract is removed from the tobacco residue, the type of drying and conditions are not disclosed. Clapp et al. also do not disclose the particular drying technique used but indicate that after an extraction process:

It often is convenient to dry the treated tobacco residue prior to the time that the aqueous solution of extracted components is applied thereto. For example, the treated tobacco residue in the form of strip or cut filler, or which is reformed using a reconstitution process, can be dried to a moisture level of less than about 15 weight percent; and then the aqueous solution of extracted tobacco components can be applied thereto. As another example, a papermaking technique for providing reconstituted tobacco can be employed (i.e. the treated tobacco residue can be formed into a sheet, the treated tobacco extract can be sprayed onto the sheet and the resulting mixture is dried)...Manners and methods for drying the treated tobacco residue and the treated tobacco extract applied thereto will be apparent to the skilled artisan. Typically, the treated tobacco residue and treated extract combined therewith are dried to a moisture level of about 12 to about 13 weight percent for used as a smokable reconstituted tobacco material (col. 7, 6-30).

Although Clapp et al. do not expressly disclose drying under vacuum, drying for 36-48 hours, or drying at 35 C, it would have been obvious to use reduced pressure (i.e. vacuum), increased heat, or long time periods to dry wet material. These methods of drying are well known to one of ordinary skill (vacuum filtration), as well as lay people (for instance drying laundered clothing with heat (clothes dryer) or extended time (on a clothes line). It would have been obvious to one of ordinary skill to apply these well known methods to drying the tobacco because both Kierulff et al. and Clapp et al. teach the importance of drying, and one of ordinary skill would be aware that wet tobacco would not be useful in conventional end products (i.e. smoking articles).

(10) Response to Argument

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **specific order of steps**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellant argues that, "...it is evident that the invention yields unexpected properties due to the specific process steps and the specific order in which they are carried out" (Appeal Brief filed12/20/2010, page 5, paragraph 4). As stated in the final rejection, the instant claims do not claim a specific order. Although steps a, b, and c,

cannot be performed in any other order, there is no indication that step d (the elimination of ribs) occurs at a specific stage in the process.

The appellant alleges that the instant process yields unexpected results and evidence of the unexpected results can be found in examples 2 and 4 of the instant specification. The examiner disagrees for the reasons below:

First, the evidence provided in the specification does not indicate that the results are unexpected when compared to the closest prior art (Kierulff et al.). The data indicates nicotine reduction due to the process versus no process. No prior art processes are compared.

Second, the process of Kierulff et al. recites the same steps as the claimed process steps (in the same order) and the results from the process of Kierulff et al. and the steps of instant claims would be expected to be the same. If appellant arguement is that step d is required to be performed after the other steps, it is noted that such an argument is not commensurate is scope with the claims.

Third, Kierulff et al. appear to indicate that ribs are removed in the process, stating: "Preferably the tobacco material used as a starting material for the present invention is the lamina portion of the tobacco leaf" (col. 3, 6-8). Therefore, one reading this disclosure in combination with the teachings of Wochnowski et al it would found it obvious for to remove the ribs (leaving the lamina portion of the leaf) via the process of Wochnowski et al.

In response to appellant 's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which applicant relies (i.e., "**The use of any kind of enzyme is not foreseen in the present invention"**, Appeal Brief, page 7, paragraphs 1and 2) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellant argues that Kierulff et al. do not disclose drying and curing the leaves before the extraction step is carried out. This is incorrect. Kierulff et al. disclose that the material treated in their process is **flue cured Virginia Tobacco** (col. 20, 49-51) that is 85% dried matter (i.e. it has been dried). It is inherent and notoriously well known in the art that curing tobacco causes the tobacco to be cured and dried. This is supported by the reporting of the moisture content of the cured tobacco by Kierulff et al. One of ordinary skill would have understood that tobacco with only 15% moisture has been dried and that the original leaves would have had far more moisture.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael J Felton/
Examiner, Art Unit 1747

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1747

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